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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,905	06/29/2001	Akiko Naruse	04329.2589	4929

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
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WASHINGTON, DC 20005

EXAMINER	
HASHEM, LISA	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 03/09/2004 5

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/893,905	Applicant(s) NARUSE ET AL.	
	Examiner Lisa Hashem	Art Unit 2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/6-29-2001*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-14 are pending in this office action.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 4, is attached to the instant office action.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 29, 2001 have been accepted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6 and 13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP Patent Application No. 2000134316 by Osamu.

Regarding claim 6, Osamu discloses a communication terminal (see Figure 1) adapted to be connected to a network which provide a service function for notifying of a message that contains a caller phone number and a caller name, the communication terminal comprising: a phone book or table (Figure 1, 8a) for storing user identification information contains a user phone number and a user name to be associated with the user phone number for each communication party user; message receiving means for receiving the caller phone number and the caller name in the message from said network included in an incoming call signal; comparing

means for comparing the received caller phone number with each of the stored user phone number stored in said phone book; and display control means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number stored in said phone book (see Abstract; column 4, line 1 – column 5, line 15; see Figure 3).

Regarding claims 13, Osamu discloses a radio communication terminal (see Figure 1) comprising: a phone book or table (Figure 1, 8a) for storing user identification information contains a user phone number and a user name to be associated with the user phone number for each communication party user; receiving means for receiving an incoming call signal including a caller phone number and a caller name; comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book; and display control means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number stored in said phone book (see Abstract; column 4, line 1 – column 5, line 15; see Figure 3).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-5 and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over European Patent Application No. EP 498,997 by Martensson in view of JP Patent Application No. 2000134316 by Osamu.

Regarding claim 1, Martensson discloses a communication terminal (Figure 1, 1) adapted to be connected to a network which provides a service function for notifying of a message that contains a caller phone number, the communication terminal comprising (column 1, lines 1-14): a phone book or memory (Figure 2, 100) for storing user identification information contains a user phone number and a user name to be associated with the user phone number for each communication party user (column 2, lines 24-29); message receiving means for receiving the caller phone number in the message from said network included in an incoming call signal (column 6, lines 1-13); display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means (column 6, lines 11-32); and a second display mode for displaying only the stored user identification information stored in phone book (column 7, lines 2-21); determining means for inherently determining whether the first display mode or second display mode is set by said display mode setting means; and display control means for selectively displaying the received caller name and the stored user name corresponding to the stored user phone number which coincides with the received caller phone number according to the determination result of the determining means (Figure 5: 108, 114).

Martensson does not disclose a service function for notifying of a message that contains a caller phone number and a caller name, the communication terminal comprising: message receiving means for receiving the caller phone number and the caller name in the message from said network included in an incoming call signal.

Osamu discloses a communication terminal (Figure 1) adapted to be connected to a

network which provides a service function for notifying of a message that contains a caller phone number and a caller name, the communication terminal comprising: a phone book or table (Figure 1, 8a) for storing user identification information contains a user phone number and a user name to be associated with the user phone number for each communication party user (Figure 2); message receiving means for receiving the caller phone number in the message from said network included in an incoming call signal; display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means; and a second display mode for displaying only the stored user identification information stored in phone book; determining means for inherently determining whether the first display mode or second display mode is set by said display mode setting means; and display control means for selectively displaying the received caller name and the stored user name corresponding to the stored user phone number which coincides with the received caller phone number according to the determination result of the determining means (see Abstract; column 4, line 1 – column 5, line 15; see Figure 3).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the communication terminal of Martensson to include a caller name in the message from said network as taught by Osamu, to provide identification of the source of call origination. One of ordinary skill in the art would have been lead to make such a modification since the called party can know detailed information related to the caller, such as a caller name. The received caller information that includes the caller name would be selectively displayed when the first display mode is set.

Regarding claim 2, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses said display control means displays only the message received by said message receiving means, when the first display mode is set (column 6, lines 1-22; Figure 5, 108).

Regarding claim 3, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses the display control means further comprises comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book, when the second display mode is set; and means for displaying the stored user identification information including said one of the stored phone number, when the received caller phone number coincide with one of the stored user phone number; wherein the text field in the memory does not include a field (column 6, line 42 - column 7, line 21; Figure 5, 114).

Regarding claim 4, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses the display control means further comprises comparing means for comparing the received caller phone number with each of the stored user phone number stored in said phone book, when the second display mode is set (column 6, line 14-16; column 6, lines 23-41).

Martensson fails to disclose means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number is not stored in said phone book.

Osamu discloses the display control means further comprises comparing means for comparing the received caller phone number with each of the stored user phone number stored in

said phone book, when the first display mode is set; and means for displaying the received caller name, when the received caller phone number does not coincide with one of the stored user phone number is not stored in said phone book (see Abstract; column 4, line 1 – column 5, line 15; see Figure 3).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the communication terminal of Martensson to include a caller name in the message from said network as taught by Osamu, to provide identification of the source of call origination. One of ordinary skill in the art would have been lead to make such modification since the called party can know detailed information related to the caller, such as a caller name. The received caller information that includes the caller name would be selectively displayed when the received caller phone number is compared with each of the stored user phone number stored in said phone book.

Regarding claim 5, the communication terminal according to claim 1 mentioned above, wherein Martensson further discloses, when said determining means determines whether the first display mode is set, a second display mode is set, or a third display mode for displaying both of the received message and user identification information stored in said phone book is set, and wherein, when it is determined by said determining means that the third display mode is set, said display control means displays both of the message received by said message receiving means and said user identification information stored in phone book; wherein the text field in the memory includes a field, e.g. "TECHNOPHONE LTD" (column 7, lines 22-28; Figure 5, 115).

Regarding claims 8-12, please see the rejection of the communication terminal in claims 1-5 mentioned above, respectively, to reject the radio communication terminal in claims 8-12.

8. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP Patent Application No. 2000134316 by Osamu as applied to claims 6 and 13 mentioned above, respectively, and in further view of European Patent Application No. EP 498,997 by Martensson.

Regarding claims 7 and 14, the communication terminal according to claims 6 and 13 mentioned above, respectively, wherein Osamu does not disclose said display control means displays the received caller name and the stored user name corresponding to the stored user phone number which coincides with the received caller phone number, when the received phone number coincides with one of the stored user name.

Martensson discloses a communication terminal (Figure 1, 1) adapted to be connected to a network which provides a service function for notifying of a message that contains a caller phone number, the communication terminal comprising (column 1, lines 1-14): a phone book or memory (Figure 2, 100) for storing user identification information contains a user phone number and a user name to be associated with the user phone number for each communication party user (column 2, lines 24-29); message receiving means for receiving the caller phone number in the message from said network included in an incoming call signal (column 6, lines 1-13); display mode setting means for selectively setting a first display mode for displaying only the received message received by said message receiving means (column 6, lines 11-32); and a second display mode for displaying only the stored user identification information stored in phone book (column 7, lines 2-21); determining means for inherently determining whether the first display mode or second display mode is set by said display mode setting means; and display control means for selectively displaying the received caller name and the stored user name

corresponding to the stored user phone number which coincides with the received caller phone number according to the determination result of the determining means (Figure 5: 108, 114).

Martensson further discloses said display control means displays both of the message received by said message receiving means and said user identification information stored in phone book; wherein the text field in the memory includes a field, e.g. "TECHNOPHONE LTD" (column 7, lines 22-28). The CLI and the text are both displayed in Figure 5, 115.

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the radio communication terminal of Osamu to include both of the message received by said message receiving means and said user identification information stored in phone book as taught by Martensson, to provide identification of the source of call origination. One of ordinary skill in the art would have been lead to make such modification since the called party can know detailed information related to the caller, such as a caller name. The received caller information that includes the caller name and the stored caller name would be displayed when the received caller phone number is compared with each of the stored user phone number stored in said phone book.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- U.S. Patent Application Publication No. US 2003/0147518 by Albal et al teach a system and method of identifying a caller is provided. A determination is made as to whether a caller's number is associated with a stored number in a called party's address book. A name and location associated with the stored number is delivered by the communication node to provide the name and location of the caller to the subscriber

10. Any response to this action should be mailed to:

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Or faxed to:

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Or call:

(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (703) 305-4302. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

LH
lh
March 2, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600